

### **REMARKS/ARGUMENTS**

The office action of September 24, 2003 has been carefully reviewed and these remarks are responsive thereto. By the present amendment, Applicants have amended claims 1, 2, 4-11, 13-15, 18, 19, 22-28 and 35, canceled claims 17, 29-34, 36-42, 44 and 46-47, and added new claims 48-62. Claims 1-15, 18-28, 35, 45, and 48-62 are pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

#### ***Rejections Under 35 U.S.C. § 102***

Claims 1-4, 8-15, 17-42 and 43-45 stand rejected under 35 U.S.C. § 102(b) as being anticipated by mValue. Claims 17, 29-34, and 43-44 are canceled, rendering this rejection moot with respect to these claims. Applicants respectfully traverse this rejection with respect to claims 1-4, 8-15, 18-28, 35, and 45 for at least the following reasons.

In order to reject a claim as anticipated under 35 U.S.C. § 102, a single prior art reference must teach every aspect of the claimed invention. MPEP § 706.02. mValue discusses a general method for controlling personal information, and for selectively sharing personal information with advertisers.

Amended claim 1 recites:

1. A method for controlling access, use and distribution of personal data of a user stored in a personal repository, the method comprising the steps of:

receiving input defining personal data comprising a master profile and one or more service profiles for storage in the personal repository, the master profile and one or more service profiles corresponding to the user;

receiving user input identifying one of the service profiles stored in the personal data repository as corresponding to a second party;

reaching an agreement, between the user and the second party, regarding release to the second party of the identified service profile; and

providing the identified service profile from the personal data repository to the second party according to the agreement.

The mValue reference at least does not teach or suggest defining personal data comprising a master profile and one or more service profiles, and recited in the amended claim. In addition, the mValue reference does not teach or suggest receiving user input identifying one of the service profiles stored in the personal data repository as corresponding to a second party. To the contrary, in the mValue reference, the second party apparently asks the user for specific information; the user does not identify a service profile as corresponding to the second party as claimed.

In addition to the above, Applicants respectfully submit that the mValue reference is not enabling. Specifically, with respect to the mExchange feature of the mValue reference, which the office action appears to rely on, the mValue reference admits that this feature is not yet implemented and thus provides only a very limited high-level description on this feature. Even if mValue tangentially describes a system similar to that which is claimed, which Applicants maintain that it does not, the mValue reference is not enabling. A reference is only valid insofar as it is enabling. See, e.g., *Lacks Industries Inc. v. McKechnie Vehicle Components USA Inc.*, 66 U.S.P.Q.2d 1083 (Fed. Cir. 2003). The mValue reference thus does not anticipate amended claim 1.

Dependent claims 2-4 and 8-15 are dependant back to claim 1, and thus allowable based on the allowability of amended claim 1.

In addition, with respect to claim 8, the mValue reference does not teach or suggest that the identified service profile comprises music preferences. To the contrary, mValue, at best, describes a system that monitors a user's web browsing history and directs advertisements to the user while the user is browsing the web.

Similarly, with respect to claim 9, the mValue reference does not teach or suggest the second party comprises a financial institution, and wherein the identified service profile comprises financial information.

With respect to claim 14, the mValue reference does not teach or suggest receiving user input defining a type of actions to be automatically recorded.

Amended claims 18, 25, and 35, similar to claim 1, recites "said personal data comprising a master profile and one or more service profiles...." Claims 18, 25 and 35 are thus allowable for

similar reasons as claim 1. Claims 19-24, dependant back to claim 18, and claims 26-28, dependant back to claim 25, are allowable based on the allowability of their respective base claims.

In addition, with respect to claim 22 and 26, mValue does not teach or suggest the second party comprises a financial institution, and wherein the identified service profile comprises financial information.

With respect to claim 24 and 28, mValue does not teach or suggest that the history recorder includes an action selector by which the user, via the user device, can define the actions to be automatically recorded.

Claim 45 recites, inter alia, a mobile device comprising:

a rules enforcer to enforce the rules by which the personal data of the user can be accessed and used by a second party device, the rules having been agreed to by the user and a second party associated with the second party device;

...  
the data storage device is arranged to have recorded therein at least a portion of *a service profile including information regarding what portions of the stored personal data of the user can be released to the second party and conditions under which the portions of the service profile can be released to the second party*

(emphasis added). The mValue reference does not teach or suggest a mobile device, much less a mobile device comprising a rules enforcer, a data storage device, and at least a portion of a service profile as claimed.

### ***Rejections Under 35 U.S.C. § 103***

Claims 5-7 and 46-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over mValue. Claims 46 and 47 have been canceled, rendering this rejection moot with respect to these claims.

The Office Action maintains that claims 5-7 do not recite functional differences over the cited mValue reference. Applicants must respectfully disagree. Each of claims 5-7 recite a step of storing the personal data in various locations or on various devices. Each claim provides an additional functional step that introduces new functional recitations to each claim. If the rejection is

Appln. No.: 09/988,002  
Amendment dated January 22, 2004  
Reply to Office Action of September 24, 2003

maintained, the examiner is kindly requested to provide support for the proposition that a step of storing personal data is not functional.

*New Claims*

Applicants have added new claims 48-62. Support for the new claims can be found in the specification as filed. No new matter has been added.

**CONCLUSION**

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,  
BANNER & WITCOFF, LTD.

Dated this 22 day of Jan., 2004

By:

  
Ross Dannenberg, Registration No. 49,024

1001 G Street, N.W.  
Washington, D.C. 20001-4597  
Tel: (202) 824-3000  
Fax: (202) 824-3001  
RAD/mmd